

REMARKS/ARGUMENTS

Claims 7, 20, and 21 have been amended in accordance with the Examiner's suggestions to correct minor draft errors. Claims 1, 15, and 29 have been amended to emphasize that the axis of rotation of the object is at a canted angle.

The rejection of Claims 1 – 3, 5, 15 – 17, 19, 29 – 31, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Swift (US Patent 4,472,822) in view of Schwartz (US Patent 6,400,791), the rejection of Claims 4, 18, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Swift and Schwartz and further in view of Hsieh (US Patent 6,226,350), and the rejection of Claims 6, 20, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Swift and Schwartz and further in view of Besson et al. (US Patent 6,301,325) and Feldkamp et al. ("Practical cone-beam algorithm) are each respectfully traversed.

Without conceding anything about the reasons for the rejection of the dependent claims, the basis for the rejection of claims 1, 15, and 29 is flawed. Fundamental to the claims is the combined requirement that the object be rotated and that the axis of rotation of the object be at a canted angle with respect to the image plane. The rejected claims have been amended to emphasize that it is not the object that is at a canted angle with respect to the image plane, but the axis of rotation of the object is at a canted angle.

The Examiner acknowledges that Swift does not disclose having an image plane at a canted angle and cites Schwarz as purportedly teaching that feature. But Schwarz does not teach that feature. Schwarz' object doesn't rotate at all. It is Schwarz' X-ray source that rotates, on the rotary ring. The Examiner appears to be contending that one could substitute Schwarz' patient support mechanism for Swift's rotary support, but that would be well outside the expectation of either inventor and contrary to Schwarz' purpose, which is to move the patient (object) in a linear movement relative to the detector, i.e., along the Z – axis shown in Schwarz' Figure 2. Moreover, substituting Schwarz' patient support for the Swift's rotary support would not only be tremendously expensive to construct and awkward to operate (no doubt throwing the Swift patient off his stool), but it would change the principle of operation of the Swift device, which is to

view a horizontal section of interest, and defeat the purpose of the Schwarz mechanism, which is to move the patient linearly, not rotationally, relative to the detector.

See M.P.E.P. 2143.01, which states, in relevant part, that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the reference. There is no teaching, suggestion, or motivation in Swift to incorporate the linearly moving patient support of Schwarz, nor is there any teaching, suggestion, or motivation in Schwarz to rotate his patient as in Swift. See also at M.P.E.P. 2143.01, the well established principle that "[i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The only suggestion to have the axis of rotation of the object canted with respect to the image plane is from applicant. Of course, hindsight is a marvelous tool for taking undirected pieces of a puzzle and, following the directions provided only by the patent claims, attempting to duplicate the claims. While it is true that "[t]he suggestion to combine may be found ... from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." (*WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999)), there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1456; see also *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). ("[A] rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

The Examiner is thanked for allowing claims 7 – 14, 21 – 28, and 35 – 42.
Applicant believe the remaining claims are in condition for allowance and respectfully
solicit a Notice of Allowance.

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